## REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed June 12, 2007. In the Office Action, the Examiner notes that claims 1-25 are pending and rejected.

In view of the foregoing amendments and the following discussion, Applicant submits that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Further, Applicant believes that all of the claims satisfy the requirements of 35 U.S.C. §112, ¶1. Thus, Applicant believes that all of the claims are now in allowable form.

It is to be understood that Applicant does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response including amendments.

### 35 U.S.C. §112, ¶1, Rejection of Claims 1-25

Claims 1-25 are rejected under 35 U.S.C. §112, ¶1, a failing to comply with the written description requirement. In response, the Applicant herein amends independent claims 1, 8, 22 and 23.

The Applicant notes that the courts have interpreted 35 U.S.C. § 112 such that the specification and claims may not be rejected for lack of written description under 35 U.S.C. §112, first paragraph, when details in the claims that are not described in the specification are within the level of ordinary skill in the art. *In re* Skrivan, 427 F.2d 801, 166 USPQ 85, 88 (C.C.P.A. 1970). Notably, the written description and enablement requirement generally requires the applicant to describe the invention to one of ordinary skill in the art. The Court has held that "[n]ot every last detail is to be described, else patent specifications word turn into production specifications, which they were never intended to be." *In re* Gay, 309 F.2d 769, 135 USPQ 311, 316 (C.C.P.A. 1962).

In view of the above amendments and requirements of 35 U.S.C. § 112, the Applicant respectfully submits that claims 1-25 now fully satisfy the requirements of 35 U.S.C. § 112. Specifically, the written description for the "means to demultiplex video,

audio, graphics and text" may be found in the Applicant's specification on at least page 31, lines 24-28. Moreover, in conjunction with the Level D upgrade module discussed on page 36, lines 1-6, one skilled in the art would know how to demultiplex an audio portion of a program signal similar to the way the video, graphics and text are demultiplexed as described on page 31, lines 24-28. Similarly, one skilled in the art would know that the upgrade module processes the independent audio (e.g. a digital radio program) in light of the specification's discussion of upgrade modules and how the upgrade module is connected to the set top terminal. (See e.g., Applicant's specification, p. 35, ll. 1-4; p. 36, ll. 1-6).

Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn

**35 U.S.C. §103 Rejection of Claims 1-7**

The Examiner has rejected claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over Goldstein U.S. Patent 5,410,326 (hereinafter "Goldstein") in view of Seth-Smith et al. U.S. Patent 4,890,321 (hereinafter "Seth-Smith"). Applicant respectfully traverses the rejection.

Claim 1 recites:

> 1. A set top terminal for generating an interactive electronic program guide for display on a television connected thereto, the terminal comprising:
> means for retrieving information about a subscriber;
> means for receiving a television signal;
> means for extracting individual programs from the television signal;
> means to demultiplex video, audio, graphics and text;
> means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal and the audio is accessed simultaneously while the television signal is being displayed;
> means for generating an electronic program guide for controlling display of content on a television screen, the guide comprising a plurality of menus including:
> a home menu;
> a plurality of major menus displayed as menu options on the home menu;
> a plurality of sub-menus displayed as menu options on the

plurality of major menus; and

a plurality of during programming menus enacted after selection of a program,

wherein at least one of the plurality of menus comprises the demultiplexed video, graphics and text, and wherein at least one of the plurality of major menus comprises displaying a plurality of audio choices for accessing the audio; and

means for receiving the selection signals from a user input. (emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Goldstein and Seth-Smith references alone or in combination fail to teach or suggest Applicant's invention as a whole.

In an exemplary embodiment of the present invention the Applicant's invention provides a means such that a subscriber may separately access digital radio channels while other programming is being viewed on the television. (See e.g., Applicant's specification, p. 36, ll. 1-6.) A level D upgrade module may be used in conjunction with a set top terminal to provide the above features. (See *Id.*).

The Applicant respectfully submits that Goldstein and Seth-Smith, alone or in any permissible combination, fail to teach or suggest a set top terminal comprising a means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal and the audio is accessed simultaneously while the television signal is being displayed, as positively recited by Applicant's independent claim 1.

Goldstein discloses a "universal remote control device which is programmed to operate a variety of consumer products" (Abstract). Goldstein is silent to a feature of a set top terminal having a means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being

displayed, wherein the audio is independent from the television signal and the audio is accessed simultaneously while the television signal is being displayed.

In addition, Seth-Smith fails to bridge the substantial gap left by Goldstein. Seth-Smith only teaches a communications format for a subscription television system permitting transmission of individual text messages to subscribers. (See Seth-Smith, Abstract). Notably, Seth-Smith is also silent as to teaching or suggesting a set top terminal having a means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal and the audio is accessed simultaneously while the television signal is being displayed.

As such, claim 1 is patentable over Goldstein in view of Seth-Smith under 35 U.S.C. §103(a). Furthermore, claims 2-7 depend, directly or indirectly, from independent claim 1, while adding additional elements. Therefore, claims 2-7 are also patentable over Goldstein in view of Seth-Smith under §103 for at least the same reasons that claim 1 is patentable over Goldstein in view of Seth-Smith under §103. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 22 and 23**

The Examiner has rejected claims 22 and 23 under 35 U.S.C. §103(a) as being unpatentable over Banker et al. (U.S. Patent 5,477,262, hereinafter "Banker") in view of Seth-Smith.

Claim 22 recites:

> 22. A set top terminal for generating an interactive electronic program guide for display on a television connected to the set top terminal, the terminal comprising:
> means for retrieving information about a subscriber;
> means for receiving a television signal;
> means for extracting individual programs from the television signal;
> means to demultiplex video, audio, graphics and text;
> means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal and the audio is accessed simultaneously while the television signal is being displayed;
> means for generating an electronic program guide for controlling

display of content on a television screen, the guide comprising a plurality of menus including:

a plurality of interactive menus, each corresponding to a level of interactivity and having one or more interactive menu items for selection; and

a main menu having one or more main menu items for selection, which main menu items correspond to the interactive menus, wherein the menus are navigated using a user input, and wherein the main menu items and the interactive menu items are responsive to selection signals received from the user input,

wherein at least one of the plurality of menus comprises the demultiplexed video, graphics and text, and wherein at least one of the plurality of menus comprises displaying a plurality of audio choices for accessing the audio; and

means for receiving the selection signals from the user input. (emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Goldstein and Seth-Smith references alone or in combination fail to teach or suggest Applicant's invention as a whole.

In an exemplary embodiment of the present invention the Applicant's invention provides a means such that a subscriber may separately access digital radio channels while other programming is being viewed on the television. (See e.g., Applicant's specification, p. 36, ll. 1-6.) A level D upgrade module may be used in conjunction with a set top terminal to provide the above features. (See *Id.*).

The Applicant respectfully submits that Banker and Seth-Smith, alone or in any permissible combination, fail to teach or suggest a set top terminal comprising a means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal and the audio is accessed simultaneously while

the television signal is being displayed, as positively recited by Applicant's independent claim 22.

Banker only teaches a method and apparatus for providing an on-screen user interface for a subscription television terminal. (See Banker, Abstract). Banker is silent to a feature of a set top terminal having a means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal and the audio is accessed simultaneously while the television signal is being displayed.

In addition, Seth-Smith fails to bridge the substantial gap left by Banker. Seth-Smith only teaches a communications format for a subscription television system permitting transmission of individual text messages to subscribers. (See Seth-Smith, Abstract). Notably, Seth-Smith is also silent as to teaching or suggesting a set top terminal having a means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal and the audio is accessed simultaneously while the television signal is being displayed.

As such, claim 22 is patentable over Banker in view of Seth-Smith. Claim 23 recites relevant limitations similar to those recited in claim 22 and, accordingly, for at least the same reasons discussed above with respect to claim 22, claim 23 also is patentable over Banker in view of Seth-Smith. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 8-21**

The Examiner has rejected claims 8-21 under 35 U.S.C. §103(a) as being unpatentable over Banker in view of Seth-Smith and U.S. Patent 5,539,871 to Gibson (hereinafter "Gibson"). Applicant respectfully traverses the rejection.

Claim 8 recites:

> 8. A set top terminal for generating an interactive electronic program guide for display on a television connected to the set top terminal, the terminal comprising:
>
> means for receiving a television signal;
>
> means for extracting individual programs from the television signal;

means to demultiplex video, audio, graphics and text;
means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal and the audio is accessed simultaneously while the television signal is being displayed;
means for generating an electronic program guide for controlling display of content on a television screen, the guide comprising:
a plurality of menus, wherein at least one of the menus comprises the demultiplexed video, graphics and text, and wherein at least one of the menus comprises displaying a plurality of audio choices for accessing the audio;
a logo that is displayed on the television screen during one of the programs, which program has one or more interactive features; and
an overlay menu that is displayed during the one of the programs, the overlay menu including the interactive features; and
means for receiving selection signals from a user input,
wherein the logo indicates to a user that the interactive features are available for the program, and wherein the overlay menu is displayed in response to a signal received from the user input. (emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Goldstein and Seth-Smith references alone or in combination fail to teach or suggest Applicant's invention as a whole.

In an exemplary embodiment of the present invention the Applicant's invention provides a means such that a subscriber may separately access digital radio channels while other programming is being viewed on the television. (See e.g., Applicant's specification, p. 36, ll. 1-6.) A level D upgrade module may be used in conjunction with a set top terminal to provide the above features. (See *Id.*).

The Applicant respectfully submits that Banker, Seth-Smith and Gibson, alone or in any permissible combination, fail to teach or suggest a set top terminal comprising a means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being displayed, wherein the audio is

independent from the television signal and the audio is accessed simultaneously while the television signal is being displayed, as positively recited by Applicant's independent claim 8.

The teachings of Banker and Seth-Smith are discussed above. As discussed above, Banker and Seth-Smith are both silent to the feature of a set top terminal having a means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal and the audio is accessed simultaneously while the television signal is being displayed.

In addition, Gibson fails to bridge the substantial gap left by Banker and Seth-Smith. Gibson only teaches a method and system for accessing associated data sets in a multimedia environment in a data processing system. (See Gibson, Abstract). Notably, Gibson is also silent as to teaching or suggesting a set top terminal having a means to receive an upgrade module that provides separate access to the audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal and the audio is accessed simultaneously while the television signal is being displayed.

Thus, Banker, Seth-Smith and Gibson fail to teach or suggest the Applicant's claimed invention as a whole. As such, Applicant's independent claim 8 is patentable under 35 U.S.C. §103(a) over Banker in view of Seth-Smith and Gibson. Furthermore, claims 9-21 depend, directly or indirectly from independent claims 8 and 23, while adding additional elements. Therefore, claims 9-21 are also patentable over Banker in view of Seth-Smith and Gibson under 35 U.S.C. §103(a). Therefore, Applicant respectfully requests that the Examiner's rejection of claims 8-21, 24 and 25 under 35 U.S.C. §103(a) be withdrawn.

**35 U.S.C. §103 Rejection of Claims 24 and 25**

The Examiner has rejected claims 24 and 25 under 35 U.S.C. §103(a) as being unpatentable over Banker and Seth-Smith, as applied to claim 23 above, and further in view of Gibson. Applicant respectfully traverses the rejection.

Each of the grounds of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. §103 for the corresponding independent claims. Since the rejection of the corresponding independent claims under 35 U.S.C. §103 has been overcome, as described hereinabove, and there is no argument put forth by the Office that any other additional references supply that which is missing from Banker and Seth-Smith to render the independent claims unpatentable, these grounds of rejection cannot be maintained. Therefore, Applicant respectfully requests that the Examiner's rejection of claims 2-6 under U.S.C. §103(a) be withdrawn.

**Official Notices**

The Office Action takes numerous Official Notices. Applicant hereby traverses each Official Notice. The Examiner alleges that apparatus and/or methods taught by certain limitations are well known in the art. However, the Applicant believes that these apparatus and/or methods rejected by the Examiner using Official Notice may not be well know within the art of the present invention as recited in the pending claims. For example, the allegedly well known limitations may not be well known to be used in combination with other limitations of the claims in which they are found or in claims form which they depend.

## CONCLUSION

Thus, Applicant submits that all of the claims presently in the application are allowable. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 9/12/07

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